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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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27667	7590	10/07/2005	EXAMINER	
HAYES, SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			TRAN, SUSAN T	
			ART UNIT	PAPER NUMBER

1615

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,124

Applicant(s)

ABRAMS ET AL.

Examiner

Susan T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of applicant's Amendment filed 07/15/05.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-9 and 11-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,702,683 ('683). Although the conflicting claims are not identical, they are not patentably distinct from each other because the '683 patent claims a controlled release pharmaceutical delivery package comprising two or more different active pharmaceuticals combined in a single delivery package, segregated from one another, electrostatically deposited on a porous, permeable or semi-permeable ingestible membrane, and formed into a tablet, wherein said two or more active pharmaceuticals comprise combinations of pharmaceuticals selected from the group consisting of (a) Ketoconazole and testosterone, (b) Valacyclovir and one or both of Cimetidine and

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Probenecid, (c) Enalapril and a beta adrenergic-blocking agent, methyldopa, nitrate, a calcium blocking agent, hydrazinc, Prazosin or Digoxin, (d) Omeprazole and B12, (e) Omeprazole and Clarithromycin, (f) Tamoxifen and a diuretic, (g) Isotretinoin and an oral contraceptive, and (h) Metformin HCl and Sulfonyleurea. Membrane comprises alkali-dissolvable or acid-dissolvable material is found in claim 2. The adhesive on the outer surfaces of the membrane is found in claims 5-7. Inert coating is found in claim 9.

Claims 1 and 3-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,428,809 ('809). Although the conflicting claims are not identical, they are not patentably distinct from each other because the '809 claims a pharmaceutical delivery package comprising fixed unit dose quantities of two or more different active pharmaceutical ingredients (a) combined in a single delivery package, and (b) segregated from one another within said package. The active ingredients are segregated from one another in a compartmentalized capsule is found in claim 2. The pharmaceuticals are segregated from one another in a tablet is found in claim 3. Inert coatings are found in claim 4. Active ingredients are found in claims 5-7 and 9-12

The wordings are not exactly the same, however, both patents '683 and '809 claimed similar subject matter, e.g., a pharmaceutical delivery package suitable for two or more different active ingredients segregated from one another. There are no unusual and/or unexpected results which would rebut prima facie obvious. As such, the instant claims would have been obvious given the claims of patent '683 or '809, which set out a similar delivery package.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Depui et al. WO 97/25065.

Depui discloses a pharmaceutical dosage form comprising an enteric coated proton pump inhibitor and one or more prokinetic agents in a fixed formulation in the form of multilayer tablets, capsules (see abstract; and page 6). The dosage form can be covered with a film forming agent (page 20, lines 4-11). Proton inhibitor layer and the prokinetic agents layer are separated by an anti-tacking layer (page 20, lines 20-24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 9-12, 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Depui et al., and Sanso US 6,350,468.

Depui is relied upon for the reason stated above. Depui does not teach combination of drugs being claimed.

Sanso teaches a single unit dosage form comprising two different active ingredients being separated from one another by a membrane (see abstract). Combinations of active ingredients include omeprazole and clarithromycine (column 2, lines 15-32; and claims). Thus, it would have been obvious to one of ordinary skill in the art to modify the dosage form of Depui for the combination of omeprazole and clarithromycine to obtain the claimed invention, because Depui teaches a suitable dosage form useful for omeprazole in combination with another drug, because Depui teaches the dosage form that provides good stability of the active substances during long term storage (page 5, lines 21-22), and because Sanso teaches combination of omeprazole and clarithromycine that is useful in pharmaceutical art.

Claims 1, 3-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturzenegger et al. US 4,197,289.

Sturzenegger teaches a sustained release pharmaceutical dosage form comprising edible web having two or more medicaments electrostatically deposited onto the web that is self destructs or degradable in body fluids or enzymes (see abstract, columns 6-8, and columns 24-26). Before the deposit of the medicaments, the web can be coated with an adhesive layer (column 17, lines 5-41). The web can be processed into separate tablet layers, capsules, dragees, or suppositories (column 3, lines 38-41; and column 4, lines 58-60).

Sturzenegger does not expressly teach the fixed unit dose quantities of the medicaments. However, the advantageous results over the dosage form includes the

exactness of the preparation of a solid dosage forms, such as uniform in size, shape, release rate, and the like (column 4, lines 33-40; and column 16, lines 40-44). Thus, it would have been obvious for one of ordinary skill in the art to, by routine experimentation modify the dosage form of Sturzenegger to obtain a unit dosage form with a fixed quantities of drugs, because Sturzenegger teaches the exact and uniform deposition of the active ingredient on the web (column 11, lines 1-5), because Sturzenegger teaches the amount of active ingredient loaded can be determined by transmission spectrophotometry (column 12, lines 46-56), and because Sturzenegger teaches the advantageous results of a single dosage form containing two or more medicaments being separated by edible membrane.

Claims 1, 3-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturzenegger et al. US 4,197,289, and Digenis US 5,672,359.

Sturzenegger is relied upon for the reason stated above. Sturzenegger does not explicitly teach the compartmentalized capsule.

Digenis teaches a controlled release capsule comprising three or more distinct compartments, each compartment comprising at least one drug (see abstract; column 4, lines 49-67). The capsule comprises combination of drugs (column 5, lines 13-15). Thus, it would have been obvious for one of ordinary skill in the art to modify the capsule of Sturzenegger using the multi-compartment capsule in view of the teaching of Digenis, because Sturzenegger teaches the desirability of achieving a delivery system containing two or more drug, and because Digenis teaches the use of multi-

compartment capsule useful to provide an immediate and sustained mode of release of combination of drugs (column 1, lines 8-16; and column 5, lines 13-16).

Claims 1, 3-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturzenegger et al. US 4,197,289, and Depui US 5,672,359.

Sturzenegger is relied upon for the reason stated above. Sturzenegger does not explicitly teach the layer tablet.

Depui discloses a pharmaceutical dosage form comprising an enteric coated proton pump inhibitor and one or more prokinetic agents in a fixed formulation in the form of multilayer tablets, wherein the two active agents are separated by an anti-tacking layer (page 20, lines 20-24). Thus, it would have been obvious for one of ordinary skill in the art to modify the composition of Sturzenegger using the multilayer tablet in view of the teaching of Depui, because Sturzenegger teaches the desirability of achieving a delivery system containing two or more drug, and because Depui teaches the use of multilayer tablet containing combination of drugs that will simplify the regimen and improve the patient compliance.

Response to Arguments

Applicant's arguments filed 07/15/05 have been fully considered but they are not persuasive.

Applicant argues that Depui teaches an enteric coated pharmaceutical encased within and protected by an enteric coating, and are unavailable until the enteric coating

is dissolved. On the other hand, the claimed invention employs a pharmaceutical delivery package including an ingestible membrane having a selected permeability porosity to fluids at the selected sites within a patient's alimentary canal. Thus, applicants' claim 1, and the several claims dependent thereon cannot be said to be anticipated, or for that matter obvious from *Depui et al.* Contrary to the applicant's argument, first, the instant claims do not preclude the active ingredients from being enteric coating active ingredients. Second, the features upon which applicant relies (i.e., a contained pharmaceutical could only become available at a selected site or sites; and the pharmaceutical would then be released over time) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Third, the membrane recites in claim 1 does not relate to the enteric coating layer of the proton pump inhibitor pellet taught by *Depui*, because the instant claims do not require that the pharmaceutical ingredients cannot be coated. The membrane is referring to the material that formed into tablet or capsule (see claim 9). *Depui* discloses what are required in the claims, a dosage in a form of a tablet comprising a core containing one drug separated/segregated by a separating layer, and another layer of a drug different form that contained in the core (page 6, lines 5-16). The membrane that formed into tablet is permeable to fluid at selected site (see page 13, lines 25-27). Furthermore, the enteric coating layer on the proton pump inhibitor pellet is to control the release of the drug into the selective site or sites as desired by

the applicant. Accordingly, applicants' claim 1, and the several claims dependent thereon are anticipated by, or obvious over Depui et al.

Applicant argues that Sturzenegger fails to teach pharmaceutical ingredients combined in and separated from one another by an adjustable membrane having a selected permeability porosity to fluids at a selected site or sites within a patient's alimentary canal as required by claim 1. In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., separated from one another by an adjustable membrane having a selected permeability porosity to fluids at a selected site or sites) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Regarding the limitation recited in claim 4, the claim does not require the membrane or barrier use to separate the two pharmaceutical ingredients to be permeable porosity. Said limitation is clearly inherent because Sturzenegger teaches placing incompatible medicaments alternatively between sheets of a laminate to obtain an advantageously stable composition (column 4, lines 62-66). Accordingly, it would have been obvious to one of ordinary skill in the art to modify the multilayer dosage form of Sturzenegger to obtain the claimed invention.

Applicant argues that Sturzenegger does not teach a pharmaceutical delivery package form in part of an adjustable membrane having a selective permeability porosity to fluids at a selected site or sites. Digenis also fails to include this teaching.

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Accordingly, no combination of Sturzenegger and Digenis reasonably could be said to achieve or render obvious claim 1 or the several claims dependent thereon. Contrary to the applicant's argument, besides all the advantageous properties disclosed in column 6 for the web materials, Sturzenegger further teaches the web material to be degradable in body fluid, and the web material can contain particles of substance which swell upon contact with fluid to thereby disrupt or break the web (to be more porous as required in claims 3 and 8). In response to applicant's argument that fails to include this teaching, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claims Allowable

Claims 13-16 and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (571) 272-

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0606. The examiner can normally be reached on Monday through Thursday 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'S. Tran', with a long horizontal flourish extending to the right.

S. Tran
Patent Examiner
AU 1615